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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/652,938	09/02/2003	Manfred Watzele	RDID03056US	2575
23690	7590	12/07/2005	EXAMINER	
Roche Diagnostics Corporation 9115 Hague Road PO Box 50457 Indianapolis, IN 46250-0457			MENON, KRISHNAN S	
			ART UNIT	PAPER NUMBER
			1723	

DATE MAILED: 12/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/652,938

Applicant(s)

WATZELE ET AL.

Examiner

Krishnan S. Menon

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-12 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 02 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-12 are pending after the preliminary amendment of 1/26/04

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: It does not identify the citizenship of each inventor.

Information Disclosure Statement

The NPL document "Harvard Apparatus Internet Site" was not considered because an internet site is subject to constant changes, and, cannot be considered as a dated publication. Accordingly, this reference was stricken out from the IDS.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-3 and 6-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Manns (US 5,047,215).

Claim 1: Manns teaches a multi-well tray (figures 8-10; abstract) having plurality of chambers (28) in side-by side arrangement, with circumferential walls, membrane

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(22: see column 4 lines 29-35), the membrane is fixed at the periphery of each well by clamping between the front face (37) of the chamber wall and fixing parts (50,52), with grooves (38, 60) and ridges (44,58). See also figure 5-7. The 'microdialyser' in preamble has no particular patentable weight other than being the intended use; the multi-well plate of the reference is capable of such use. With respect to the "semipermeable membrane", given the broadest reasonable interpretation of the claim, the reference teaches a semipermeable membrane (cellulose acetate, etc – column 4 lines 29-35). 'Diffusion exchange between the sample chamber and the ... dialysate chamber ("dialysate chamber" is intended use) ... only possible through this membrane' is functional language, which the reference device is capable of; the molecular weight cut-of of the membrane is not positively recited.

Claim 2: membrane area is less than 50 mm² – see column 1 lines 15-20 giving the diameter of the well at 0.66 cm, which has an area of about 32 mm².

Claim 3: at least a part of the sample chambers are in liquid exchange contact with a dialysate chamber ("dialysate chamber" is intended use): all the wells in the reference can be in liquid exchange contact with the chamber (46), as seen in figure 1. 'At least part of' would include all sample chambers. The chamber 46 is not in liquid contact with any other different set of sample chambers.

Claim 6: common dialysate chamber – 46.

Claim 7: common fixing part – see figure 10.

Claim 8: cellulose acetate membrane – column 4 lines 29-35.

Claim 9-11: 96-array – see figure 1.

Claim 12: 9 mm center – center – column 1 line 20.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/44877 (US equivalent in English: Schels et al, US 6,670,173; herein after, Schels) in view of Manns (US 5,047,215).

Schels teaches a microdialysis device having a sample chamber (12) and dialysate chamber 10 separated by membrane 7; the periphery of the membrane 7 is fixed in compression between the groove on the circumferential ring part of the chamber 10 and the ridge on the bottom face of the sample chamber wall (see figure 5; and also figures 2-4). Sample chamber is open only to dialysate chamber 10 via the membrane 7 – having a individual dialysate chambers for the sample chamber. The membrane is cellulose acetate (column 4 line 63).

The teaching of the reference differs from the instant claims in the plurality of sample chambers, common dialysate chamber, dimensions such as wall thickness, membrane area, spacing of the sample chambers and the number of sample chambers in the device. All these are taught by the Manns reference as shown in paragraph 1 above. It would be obvious to one of ordinary skill in the art at the time of invention to

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use the teaching of Manns in the teaching of Schels for having a multiwell device for simultaneously handling multiple samples as taught by Manns (column 1 lines 10-20) for bioreactions as taught by Schels. Such multiwell plates are also well known in the art as taught by Manns.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S. Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Krishnan S. Menon
Patent Examiner
December 2, 2005